



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Thomas J. BRENNAN

Group Art Unit: 1636

Serial No.: 09/900,699

Examiner: Qian, Celine X.

Filed: July 6, 2001

Attorney Docket No.: R-173

For: TRANSGENIC MICE CONTAINING DEZ ORPHAN
RECEPTOR GENE DISRUPTIONS

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action mailed September 24, 2002, concerning the Examiner's restriction to the claims, Applicants hereby provisionally elect, with traverse, Invention I (claims 1-10 and 17-19), drawn to a DEZ knockout targeting construct, a method of making said targeting construct, a cell comprising a disruption in a DEZ receptor gene, a non-human transgenic animal comprising a disruption in a DEZ receptor gene and a method making said transgenic animal.

In the restriction, the Examiner asserts that claims 1-20 are drawn to eight distinct subjects, grouped as: Invention I (claims 1-10 and 17-19), drawn to a DEZ knockout targeting construct, a method of making said targeting construct, a cell comprising a disruption in a DEZ receptor gene, a non-human transgenic animal comprising a disruption in a DEZ receptor gene and a method making said transgenic animal; Invention II (claim 11), drawn to a method of identifying an agent that modulates the expression of DEZ by using a DEZ knockout animal; Invention III (claim 12), drawn to a method of identifying an agent that modulates the function of DEZ by using a DEZ knockout animal; Invention IV (claims 13 and 15), drawn to a method of identifying an agent that modulates the expression of DEZ receptor by using a DEZ knockout cell; Invention V (claims 14 and 15), drawn to a method of identifying an agent that modulates

the function of a DEZ gene by using a DEZ knockout cell; Invention VI (claim 16), drawn to an agent that modulates the expression of DEZ gene; Invention VII (claim 16), drawn to an agent that modulates the function of DEZ gene; and Invention VIII (claim 20), drawn to a database containing phenotypic data associated with the DEZ knockout mouse.

Specifically, the Examiner asserts that Invention I is patentably distinct from each of Inventions II-V, because the product of Invention I can be used in the methods of Inventions II-V. The Applicant disagrees with the Examiner's assertion in that the claims of Invention I are related to the methods of Inventions II-V and therefore would not require a separate search or examination that would seriously burden the Examiner.

The Examiner further asserts that the product of Invention VI is patentably distinct from the methods of Inventions II or IV, as they are related as the process of making and the product made. The Applicant disagrees with the Examiner in that the claims of Inventions II, IV and VI are related and a search and examination of these claims can be made without serious burden on the Examiner.

The Examiner also asserts that the product of Invention VII can be made by the methods of Inventions III or V, and is therefore patentably distinct from the methods of Inventions III or V, as they are related as the process of making and the product made. The Applicant disagrees with the Examiner's assertion in that the claims of Inventions III, V and VII are related. Therefore, a separate search and examination of these claims is not necessary and can be made without serious burden on the Examiner.

According to the Examiner, claims of Inventions I and VI-VIII are patentably distinct, as they are biologically, chemically and functionally distinct compositions, and drawn to materially distinct compositions that are not directly related. The Applicant disagrees with the Examiner's conclusion in that the claims of Inventions I and VI-VIII are related. Thus, a search and examination on these claims can be made without serious burden to the Examiner.

It is also asserted by the Examiner that Inventions II-V are patentably distinct from each other because the inventions are drawn to methods that require different starting materials and different modes of operation. The Applicant disagrees with the Examiner's assertion in that the methods of Inventions II-V are related, and therefore a search and examination on these claims can be made without serious burden to the Examiner.

Although the Applicant has provisionally elected Group I for purposes of advancing prosecution of the present application, Applicant contends, for the foregoing reasons, that the restriction requirement is improper. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the requirement.

Respectfully submitted,

Date: 7 October 2002


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Enclosures